

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** NOBUYUKI KUZUTA

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Appeal No. 2000-0737  
Application No. 08/919,795

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ON BRIEF

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Before URYNOWICZ, JERRY SMITH and DIXON, **Administrative Patent Judges**.

URYNOWICZ, **Administrative Patent Judge**.

Decision on Appeal

This appeal is from the final rejection of claims 1-4.

The invention pertains to laser apparatus. Claim 1 is illustrative and reads as follows:

1. A solid state laser device comprising:  
a laser semiconductor for oscillating a light as a pumping light,  
a collimator lens for leading the laser light to parallel rays,



The burden initially is on the examiner to show a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Here, it is considered that the examiner has not carried that burden. More specifically, with respect to Figure 4 of Clark, it is considered that the examiner has not provided a motivation or suggestion as to why one of ordinary skill in the art would have modified Clark by substituting two lenses, a collimating lens in fitting 27 and a focusing lens in fitting 28, for the lens 22 in fitting 27. The examiner's observation that the two proposed lenses are equivalent to and would perform the same function as Clark's lens 22 is not controlling because that fact, by itself, is not motivation to make the change suggested by the examiner. In fact, no motivation for making the suggested changes in Clark has been given in the answer.

Even if one were to substitute the equivalent pair of lenses suggested by the examiner into Clark for lens 22, both lenses would have been positioned in fitting 27, because that is wherein lens 22 is located. No motivation has been given for placing a collimating lens in fitting 27 and a focusing lens in fitting 28.

The fact that Clark may have been modified in the manner suggested by the examiner does not make the modification obvious

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unless the prior art suggested the desirability of the  
modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d  
1780, 1783-84 n.14 (Fed. Cir. 1992).

REVERSED

STANLEY M. URYNOWICZ, JR.	)
Administrative Patent Judge	)
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	) BOARD OF PATENT
	) APPEALS AND
JERRY SMITH	) INTERFERENCES
Administrative Patent Judge	)
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	)
JOSEPH L. DIXON	)
Administrative Patent Judge	)

SLD

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Application No. 08/919,795

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